

REMARKS

Applicants gratefully acknowledges the Examiner's acceptance of the corrections to the drawings and specification.

Status of the Claims

Claims 1–23 remain pending in the application. Claims 1, 8, 13, and 22 presently are amended to clarify the invention as defined in these claims, and in regard to the claims depending therefrom.

Claims Rejected Under 35 U.S.C. § 102(b) over Borland

The Examiner restates his rejections of Claims 1, 3-9, and 11-23 as being anticipated by Russo Borland (“Running Microsoft Word 97,” published by Microsoft Press, Redmond, Washington 1997, hereinafter referred to as “Borland”). The Examiner asserts that Borland describes each element of applicants’ claimed invention. Applicants respectfully submit that Claims 1, 13, and 22, as amended, are patentably distinguishable from the applied reference for the reasons discussed below.

In the interest of reducing the complexity of the issues for the Examiner to consider in this response, the following discussion focuses on independent Claims 1, 13, and 22. The patentability of each remaining dependent claim is not necessarily separately addressed in detail. However, applicants' decision not to discuss the differences between the cited art and each dependent claim should not be considered as an admission that applicants concur with the Examiner's conclusion that these dependent claims are not patentable over the disclosure in the cited references. Similarly, applicants' decision not to discuss differences between the prior art and every claim element, or every comment made by the Examiner, should not be considered as an admission that applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the references cited. Moreover, a specific traverse of the rejection of each dependent claim is not required, since dependent claims are patentable for at least the same reasons as the independent claims from which the dependent claims ultimately depend.

With regard to independent Claim 1, the invention as defined by applicants' recited claim language is neither taught nor suggested by Borland. With regard to the Examiner's response to applicants' arguments, the claim language concerning the step of determining a sample of

1 formats comprising a plurality of formats from a format set has been amended to specifically
2 recite that the format set includes a plurality of at least one of font sets and color sets. Moreover,
3 Claim 1 has been amended to recite that a live preview window *simultaneously* displays “the
4 portion of text *reformatted in each of the formats in the sample of format, such that the user is*
5 *able to preview how the portion of text will appear in each of the formats without applying any*
6 *of the formats to the portion of the text.*” (Emphasis added.)

7 For the sake of argument, assuming that the first and second limitation of the claim were
8 described by Borland as stated in the Office Action, it should be apparent that the above quoted
9 portion of applicants’ recited claim language is neither taught nor suggested by Borland. The
10 Examiner states, that “[t]he limitation of the claim is directed toward reformatting the text and
11 displaying the result in a preview window. Borland discloses reformatted text the preview
12 window in the figure on page 61.” The Examiner is correct that the figure shown on page 61 of
13 Borland does show a preview of how a selected style would apply to a section of text. However,
14 the preview of the Borland figure on page 61 presents a preview of only *one* style. Moreover,
15 although a number of style *names* are listed in the Borland figure on page 61, only the names are
16 listed. Borland neither teaches nor suggests representation of a section of text presented in a
17 *plurality of formats* simultaneously, so that a user might compare the appearance of the section
18 of text in the different styles. Independent Claims 13 and 22, which the Examiner has rejected
19 for the same reasons as Claim 1, similarly recite this feature of the present invention, which is
20 neither taught nor suggested by the applied reference. Accordingly, applicants respectfully
21 request entry of the amendment, reconsideration of the claims, and withdrawal of the rejection of
22 independent Claims 1, 13, and 22 under 35 U.S.C. § 102(b).

23 Because dependent claims are considered to include all of the elements of the independent
24 claims from which the dependent claims ultimately depend and because Borland does not disclose or
25 suggest all of the elements of independent Claims 1, 13, and 22, the rejection of dependent
26 Claims 2-12, 14-21, and 23, under 35 U.S.C. § 102(b) over Borland should also be withdrawn for at
27 least these reasons.

28 Claims Rejected Under 35 U.S.C. § 103(a) over Borland

29 Claims 2 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Borland.
30 However, Claims 2 and 10 depend from independent Claim 1, which is patentable for the reasons

1 discussed above. Because dependent claims are considered to include all of the elements of the
2 independent claims from which the dependent claims depend, dependent Claims 2 and 10 are
3 patentable for at least the same reasons discussed above with regard to independent Claim 1.
4 Accordingly, the rejection of dependent Claims 2 and 10 under 35 U.S.C. § 103(a) should be
5 withdrawn.

6 In view of the amendments and Remarks set forth above, it will be apparent that the claims in
7 this application define a novel and non-obvious invention, and that the application is in condition for
8 allowance and should be passed to issue without further delay. Should any further questions remain,
9 the Examiner is invited to telephone applicants' attorney at the number listed below.

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11 Respectfully submitted,

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14 Ronald M. Anderson
15 Registration No. 28,829

16 FJB/RMA:lrg

17 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed
18 envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents,
19 Alexandria, VA 22313-1450, on January 19, 2005.

20 Date: January 19, 2005

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